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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/564,138

01/10/2006

Heinfried Rudolph

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1333 7590 09/19/2007
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EXAMINER

LAMB, BRENDA A

ART UNIT

PAPER NUMBER

1734

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/564,138	Applicant(s) RUDOLPH ET AL.	
	Examiner Brenda A. Lamb	Art Unit 1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 16-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1/10/06</u> | 6) <input type="checkbox"/> Other: _____ |

Applicant's election without traverse of Group I in the reply filed on 8/16/2007 is acknowledged.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-2 and 6-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following elements lack proper antecedent basis: "the coating fluid" at lines 6-7 of claim 1 at line 2 of claim 6; "the piston heads" at line 2 of claim 12; and "the piston rods" at line 2 of claim 12.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the dropping system and adjustable dam must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

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consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 13-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The originally filed specification fails to enable one to make/or use the invention as claimed with the originally filed specification failing to disclose the positioning of the adjustable dam relative to other structural elements of the assembly and how one adjusts the height of the dam to adjust the pressure of the confining fluid or coating fluid.

The originally filed specification fails to enable one to make/or use the invention as claimed with the originally filed specification failing to disclose what a dropping system encompasses.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Abe et al 5,575,851.

Abe et al teaches the design of a device for adapting the coating width of a coating system, comprising at least one limiting means limiting a coating slot, wherein the limiting means is movable and is adapted or is capable of applying a confining fluid there through. Abe et al device is capable of supplying a fluid within the scope of the

claim thereby limiting the coating width of a coating system since it teaches every positively claimed element of the apparatus, that is, limiting means which is capable of being movable in a slot and is capable of flowing a fluid there through. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Thus every element of the device of claim 3 is taught by Abe et al. With respect to claim 4, Abe et al the at least one limiting means acts as a piston or cylinder fitting and moving within the cylindrical cavity or manifold of the die coater. With respect to claim 5, Abe et al teaches the piston is provided with a sealing sheet as extending into the coating slot. With respect to claim 6, Abe et al teaches the piston is capable of being arranged in a distribution chamber. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). With respect to claims 6-8, Abe et al teaches wherein the piston is sealed off against the distribution chamber by at least one sealing element and preferably includes two sealing elements which are positioned approximately at the beginning and the end

of the sealing sheet assembly (see Figure 7 with sealing elements 6,61 arranged in the manner set forth in the claims. With respect to claim 9, Abe et al device is capable of supplying a fluid through the hollow shaft 5 and between the sealing elements as shown in Figure 7. With respect to claim 1, Abe et al teaches a device for adapting the coating width of a coating system comprising a distribution chamber having a coating slot and at least one piston with a sealing sheet, the at least one piston being arranged at one end of the distribution chamber so as to be movable along the coating slot and the sealing sheet essentially sealing off the coating slot, further comprising means for applying a confining fluid to the side of the piston facing away from the coating fluid so as to simulate a continuous material web. With respect to claim 2, the same rejection applied to claims 8-9 is applied here. With respect to claim 10, Abe et al teaches the width of the coating slot is within the scope of claim (column 2 lines 42-46). With respect to claim 11, absent a clear recitation of how the coating fluid relates to the confining fluid, Abe et al valves 9 and 10 enables one to control the amount of confining fluid relative to the amount of coating fluid used per hour. With respect to claim 14, Abe et al fluid is supplied via a dropping system as shown in Figure 11. With respect to claim 15, Abe et al is capable of supplying a fluid within the scope of the claim. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir.

1990). With respect to claim 13, absent a clear recitation of the adjustable dam relates to other structural elements of the apparatus, the positioning of the adjustable dam member within the assembly affects pressure of the fluid within the assembly. With respect to claim 12, absent a clear recitation of the piston heads and piston rods relates to the piston set forth in claim 1, Abe et al shows that the fluid is supplied to the heads of the limiting means via the hollow piston or deckle rods as shown in Figure 11.

Claims 1 and 3-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Japan 10-005663.

Japan '663 teaches the design of a device for adapting the coating width of a coating system, comprising at least one limiting means limiting a coating slot, wherein the limiting means is movable and is adapted or is capable of applying a confining fluid there through. Japan '663 device is capable of supplying a fluid within the scope of the claim thereby limiting the coating width of a coating system since it teaches every positively claimed element of the apparatus, that is, limiting means which is capable of being movable in a slot and is capable of flowing a fluid there through. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Thus every element of the device of claim 3 is taught by Japan '663 . With respect to claim 4, Japan '663 the at least one limiting means acts as a

piston or cylinder fitting and moving within the cylindrical cavity or manifold of the die coater. With respect to claim 5, Japan '663 teaches the piston is provided with a sealing sheet 3 as extending into the coating slot. With respect to claim 6, Japan '663 teaches the piston is capable of being arranged in a distribution chamber. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). With respect to claim 1, Japan '663 teaches a device for adapting the coating width of a coating system comprising a distribution chamber having a coating slot and at least one piston with a sealing sheet, the at least one piston being arranged at one end of the distribution chamber so as to be movable along the coating slot and the sealing sheet essentially sealing off the coating slot, further comprising means for applying a confining fluid to the side of the piston facing away from the coating fluid so as to simulate a continuous material web.

Claims 2 and 7-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japan 10-005663 in view of Abe et al 5,575,851.

Japan '663 is applied for the reasons noted above but fails to teach the device includes a at least one sealing element and preferably includes two sealing elements which are positioned approximately at the beginning and the end of the sealing sheet assembly. However, Abe et al teaches wherein the piston is sealed off against the

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distribution chamber by at least one sealing element and preferably includes two sealing elements which are positioned approximately at the beginning and the end of the sealing sheet assembly (see Figure 7 with sealing elements 6,61 arranged in the manner set forth in the claims). Therefore, it would have been obvious to modify the Japan '663 system by substituting its sealing sheet or deckle with deckle guide with another sealing sheet or deckle with deckle guide such as taught by Abe et al in Figure 7 for the taught advantage of preventing fluid leakage within the die coater. Thus claims 2 and 7-9 are obvious over the above cited combination of references. With respect to claim 10, Japan '663 fails to teach the width of the coating slot is within the scope of claim. Abe et al teaches the width of the coating slot is within the scope of claim (column 2 lines 42-46). Therefore, it would have been obvious to optimize the width of the Japan '663 coating slot such that it is within the scope of claim since Abe et al teaches the width of the coating slot is within the scope of claim dependent on the viscosity of the coating fluid. With respect to claim 11, absent a clear recitation of how the coating fluid relates to the confining fluid, Japan '663 valves enables one to control the amount of confining fluid relative to the amount of coating fluid used per hour (see Figures 4-5). With respect to claim 14, Japan '663 fluid is supplied via a dropping system as shown in Figure 4. With respect to claim 15, Japan '663 is capable of supplying a fluid within the scope of the claim. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647 (1987). "[A]pparatus

claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). With respect to claim 13, absent a clear recitation of the adjustable dam relates to other structural elements of the apparatus, the positioning of the adjustable dam member within the assembly affects pressure of the fluid within the assembly. With respect to claim 12, absent a clear recitation of the piston heads and piston rods relates to the piston set forth in claim 1, Japan '663 shows that the fluid is supplied to the heads of the limiting means via the hollow piston or deckle rods.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda A. Lamb whose telephone number is (571) 272-1231. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday. The examiner can also be reached on alternate Wednesdays.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Tucker, can be reached on (571) 272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink that reads "Brenda A Lamb". The signature is written in a cursive, flowing style with a large initial 'B'.

Brenda A Lamb

Examiner

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